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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/986,422	11/08/2001	Aulis Peralta	111075	5258

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EXAMINER

OCAMPO, MARIANNE S

ART UNIT	PAPER NUMBER
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1723

DATE MAILED: 10/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/986,422

Applicant(s)

PERALA, AULIS

Examiner

Marianne S. Ocampo

Art Unit

1723

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 04 September 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attachment for more details.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☒ Newly proposed or amended claim(s) 15-17 would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_.

Claim(s) objected to: 2.

Claim(s) rejected: 1 and 3-14.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☒ Other: See Continuation Sheet

*see attachment to advisory : 892* <sup>PTO</sup>

Continuation of 10. Other: PTO-892 & page 217 of Merriam-Webster Dictionary, 10th edition.

*Walker*  
W. L. WALKER

SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700

***ATTACHMENT TO THE ADVISORY ACTION***

***Response to Proposed Amendments after Final and Arguments***

1. The proposed amendments after final filed on 9-4-03 do not deemed to place the application in condition for allowance, nor a better form for appeal by materially reducing or simplifying the issues for appeal. In particular, the proposed amended claims 1 – 14 has been amended by simply changing its preamble reciting its intended use with the addition of “solid-liquid separation” in front of the term “filter cloth” in the first lines of the claims. *An intended use clause found in the preamble of an apparatus claim is not afforded the effect of a distinguishing limitation unless the body of the claim sets forth structure which refers back to, is defined by, or otherwise draws life and breadth from the preamble.* See *In re Casey*, 152 USPQ 235 (CCPA 1967); *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951). Thus, a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. See *Kropa v. Robie*, supra et 480. See also *Ex Parte Mott*, 190 USPQ 311, 313 (PTO Board of App. 1975). Furthermore, a recitation of the intended use of the claimed invention **must result in a structural difference between the claimed invention and the prior art** in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative

difference as compared to the prior art. See In re Casey, 152 USPQ 235 (CCPA 1967) and In re Otto, 136 USPQ 458, 459 (CCPA 1963). It is considered that Janovac, prior art/primary reference, is capable of filtering not only solids of different sizes but could be used in separation of solid-liquid mixtures.

2. With regards to the prior art, Janovac, and argument by the applicant that the screen or prior art product of Janovac is not a filter *cloth*, applicant is attempting to narrow the definition of what a cloth is based on a definition given by New Oxford Dictionary, which the applicant failed to provide a copy for the examiner. Attached with this advisory action is a definition for "cloth" given by Merriam Webster Collegiate Dictionary, 10<sup>th</sup> edition (the term "cloth" is defined by Merriam Webster Dictionary as "*pliable material made usually by weaving, knitting, or felting natural or synthetic fibers and filaments*"<sup>1a</sup>, page 217). It clearly does not exclude wire meshes or screens like those of Janovac. In fact, Janovac had used the term "cloth" to describe his (screen) product, as in col. 2, lines 4 – 5.

3. Applicant's arguments filed 9-4-03 have been fully considered but they are not persuasive. In particular, the argument that Janovac fails to disclose channels formed between thicker yarns which allow filtered fluid to flow therethrough (see page 8, second paragraph), is simply untrue. Applicant is correct in stating that there are some crimped wires (12) between the thicker yarns, however, between those crimped wires (12) and thicker yarns/wires (14) are small spaces or channels which could allow filtered fluid flow through, as in figure 2 of Janovac.

Furthermore, those channels between crimped wires 12 and thick yarns/wires (14) do form parallel channels.

4. Regarding the secondary references, Carr (WO 02/05974), it is true that this reference is an intervening reference, i.e. the earliest effective date which is 7/5/00 based on the filing date of US application 09/610,633, and so does Greenhalgh (US Pat. App. Pub. 2002/00663600 with an effective filing date of October 31, 2000, however, applicant's priority benefits are not automatically granted unless all conditions of 35 US 119 have been met. In this instance, the applicant has failed to provide a certified translation of the Finnish application 991381 filed on 6/16/99. **Should applicant desire to obtain the benefit of foreign priority under 35 U.S.C. 119(a)-(d) prior to declaration of an interference, a translation of the foreign application should be submitted under 37 CFR 1.55 in reply to this action.**

5. The rest of the arguments are based on the combination of teachings of the primary reference Janovac, with secondary references, Cook and Derrick, and how those rejections fail due to the deficiencies of Janovac mentioned by the applicant in pages 8 – 9 of the response filed on 9-4-03. Once again, applicant is asked to refer to the counterarguments given above in paragraphs 1 – 3 with regards to Janovac.

6. This application is subject to the provisions of Public Law 103-465, effective June 8, 1995. Accordingly, since this application has been pending for at least two years as of June 8,

1995, taking into account any reference to an earlier filed application under 35 U.S.C. 120, 121 or 365(c), applicant, under 37 CFR 1.129(a), is entitled to have a first submission entered and considered on the merits if, prior to abandonment, the submission and the fee set forth in 37 CFR 1.17(r) are filed prior to the filing of an appeal brief under 37 CFR 1.192. Upon the timely filing of a first submission and the appropriate fee of \$375 or \$750 for a small or large entity, respectively, under 37 CFR 1.17(r), the finality of the previous Office action will be withdrawn. If a notice of appeal and the appeal fee set forth in 37 CFR 1.17(e) were filed prior to or with the payment of the fee set forth in 37 CFR 1.17(r), the payment of the fee set forth in 37 CFR 1.17(r) by applicant will be construed as a request to dismiss the appeal and to continue prosecution under 37 CFR 1.129(a). In view of 35 U.S.C. 132, no amendment considered as a result of payment of the fee set forth in 37 CFR 1.17(r) may introduce new matter into the disclosure of the application.

If applicant has filed multiple proposed amendments which, when entered, would conflict with one another, specific instructions for entry or non-entry of each such amendment should be provided upon payment of any fee under 37 CFR 1.17(r).

7. Regarding the indication of allowability of newly presented claims 15 – 17, see final office action pages 12 – 13, paragraph 23. The incorporation of the allowable subject matter in claim 2 has been incorporated into the language of claims 15 – 17.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marianne S. Ocampo whose telephone number is (703) 305-1039. The examiner can normally be reached on Mondays to Fridays from 8:30 A.M. to 4:30 P.M..

9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda Walker can be reached on (703) 308-0457. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

10. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

M.S.O.